

REMARKS

Claims 1-10 were examined and reported in the Office Action. Claims 1-10 are rejected. Claims 1-10 are amended. Claims 1-10 remain.

Applicant requests reconsideration of the application in view of the following remarks.

I. 5 U.S.C. § 103(a)

A. It is asserted in the Office Action that claims 1, 2, 4 and 7 are rejected in the Office Action under 35 U.S.C. § 103(a), as being unpatentable over U. S. Patent No. 6,683,855 issued to Bordogna et al. ("Bordogna") in view of U. S. Patent No. 7,028,241 issued to Blair et al. ("Blair"). Applicant respectfully traverses the aforementioned rejection for the following reasons.

According to MPEP §2142

[t]o establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." (*In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

Further, according to MPEP §2143.03, "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (*In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974))." "*All words in a claim must be considered in judging the patentability of that claim against the prior art.*" (*In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970), emphasis added.)

Applicant's amended claim 1 contains the limitations of

[a]n optical transmission system including a plurality of layers, the system comprising: an optical transponder having a digital wrapper, the optical transponder operates to execute maintenance of a received signal in the optical transponder; the optical transponder further including: a digital wrapper interrupt processor for processing an interrupt signal generated from the digital wrapper according to monitoring of the received signal; a defect and maintenance signal detector for determining whether or not the received signal has a defect and determining whether or not the received signal requires maintenance under the control of the digital wrapper interrupt processor; a defect and maintenance signal processor for, when a defect is detected by the defect and maintenance signal detector or is cancelled, processing the defect; and a digital wrapper controller for controlling the digital wrapper according to the processing result of the defect and maintenance signal processor.

Applicant's amended claim 7 contains the limitations of

operating an optical transponder, the optical transponder operates to perform maintenance of a received signal in an optical transmission system including multiple layers, the optical transponder having a digital wrapper, the optical transponder further operates by: calling a processor for processing an interrupt when the interrupt is generated from the digital wrapper according to monitoring of the received signal; the called processor detecting what defect is generated in the received signal and detecting whether or not the received signal requires maintenance; performing defect processing in the case that a defect is detected by the called processor or is cancelled; and controlling the digital wrapper according to the defect and maintenance processing result.

Bordogna discloses error correction schemes for high speed optical transmission systems. Bordogna, however, does not teach, disclose, suggest, or even mention, an optical transponder or a method of operating an optical transponder.

Blair discloses data frame structures used in optical transport networks. Blair, however, does not teach, disclose, suggest, or even mention, an optical transponder or a method of operating an optical transponder.

Therefore, even if Bordogna and Blair were combined, the resulting invention would still not teach, disclose, suggest, or even mention the limitations contained in Applicant's amended claims 1 and 7. Since neither Bordogna, Blair, and therefore, nor the combination of the two, teach, disclose or suggest all the limitations of Applicant's amended claims 1 and 7, Applicant's amended claims 1 and 7 are not obvious over Bordogna in view of Blair since a *prima facie* case of obviousness has not been met under MPEP §2142. Additionally, the claims that directly or indirectly depend from amended claim 1, namely claims 2 and 4, would also not be obvious over Bordogna in view of Blair for the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejections for claims 1, 2, 4 and 7 are respectfully requested.

B. It is asserted in the Office Action that claims 3, 8 and 9 are rejected in the Office Action under 35 U.S.C. § 103(a), as being unpatentable over Bordogna in view of Blair and further in view of U. S. Patent No. 4,268,722 issued to Little et al. ("Little"). Applicant respectfully traverses the aforementioned rejection for the following reasons.

Applicant's amended claim 3 directly depends on amended claim 1. Applicant has addressed Bordogna in view of Blair regarding claim 1 above in section I(A). Applicant's amended claims 8 and 9 either directly or indirectly depend on amended claim 7. Applicant has addressed Bordogna in view of Blair regarding claim 7 above in section I(A).

Little discloses a telephone system for radiotelephone communications using pulse-code modulation (PCM) techniques. Little, however, does not teach, disclose, suggest, or even mention, an optical transponder or a method of operating an optical transponder.

Therefore, even if Bordogna, Blair and Little were combined, the resulting invention would still not teach, disclose, suggest, or even mention the limitations contained in Applicant's amended claims 1 and 7. Since neither Bordogna, Blair, Little, and therefore, nor the combination of the three, teach, disclose or suggest all the limitations of Applicant's amended claims 1 and 7, Applicant's amended claims 1 and 7 are not obvious over Bordogna in view of Blair in further view of Little since a *prima facie* case of obviousness has not been met under MPEP §2142. Additionally, the claims that directly or indirectly depend from amended claims 1 and 7, namely claims 3, and 8 and 9, respectively, would also not be obvious over Bordogna in view of Blair and further in view of Little for the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejections for claims 3 and 8-9 are respectfully requested.

C. It is asserted in the Office Action that claim 5 is rejected in the Office Action under 35 U.S.C. § 103(a), as being unpatentable over Bordogna in view of Blair and further in view of U. S. Patent No. 7,028,231 issued to Tezuka ("Tezuka"). Applicant respectfully traverses the aforementioned rejection for the following reasons.

Applicant's amended claim 5 indirectly depends on amended claim 1. Applicant has addressed Bordogna in view of Blair regarding claim 1 above in section I(A).

Tezuka discloses a performance monitoring technique for large capacity and long distance transmission requiring error correction processing. Tezuka, however, does not teach, disclose, suggest, or even mention, an optical transponder.

Therefore, even if Bordogna, Blair and Tezuka were combined, the resulting invention would still not teach, disclose, suggest, or even mention the limitations contained in Applicant's amended claim 1. Since neither Bordogna, Blair, Tezuka, and therefore, nor the combination of the three, teach, disclose or suggest all the limitations of Applicant's amended claim 1, Applicant's amended claim 1 is not obvious over Bordogna in view of Blair in further view of Tezuka since a *prima facie* case of obviousness has not been met under MPEP §2142. Additionally, the claim that indirectly depends from amended claim 1, namely claim 5, would

also not be obvious over Bordogna in view of Blair and further in view of Tezuka for the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejections for claim 5 are respectfully requested.

D. It is asserted in the Office Action that claims 6 and 10 are rejected in the Office Action under 35 U.S.C. § 103(a), as being unpatentable over Bordogna in view of Blair and further in view of U. S. Patent No. 6,725,032 issued to Sheridan et al. ("Sheridan"). Applicant respectfully traverses the aforementioned rejection for the following reasons.

Applicant's amended claim 6 directly depends on amended claim 1. Applicant has addressed Bordogna in view of Blair regarding claim 1 above in section I(A). Applicant's amended claim 10 directly depends on amended claim 7. Applicant has addressed Bordogna in view of Blair regarding claim 7 above in section I(A).

Sheridan discloses cell network configuration and management. Sheridan, however, does not teach, disclose, suggest, or even mention, an optical transponder or a method of operating an optical transponder.

Therefore, even if Bordogna, Blair and Sheridan were combined, the resulting invention would still not teach, disclose, suggest, or even mention the limitations contained in Applicant's amended claims 1 and 7. Since neither Bordogna, Blair, Sheridan, and therefore, nor the combination of the three, teach, disclose or suggest all the limitations of Applicant's amended claims 1 and 7, Applicant's amended claims 1 and 7 are not obvious over Bordogna in view of Blair in further view of Sheridan since a *prima facie* case of obviousness has not been met under MPEP §2142. Additionally, the claims that directly depend from amended claims 1 and 7, namely claims 6, and 10, respectively, would also not be obvious over Bordogna in view of Blair and further in view of Sheridan for the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejections for claims 6 and 10 are respectfully requested.

CONCLUSION

In view of the foregoing, it is submitted that claims 1-10 patentably define the subject invention over the cited references of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes a telephone conference would be useful in moving the case forward, he is encouraged to contact the undersigned at (310) 207-3800.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly, extension of time fees.

Respectfully submitted,

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CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being submitted electronically via EFS Web on the date shown below to the United States Patent and Trademark Office.


Jean Svoboda

Date: December 5, 2006